

ESTTA Tracking number: **ESTTA622345**

Filing date: **08/19/2014**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	91215553
Party	Plaintiff Guinot
Correspondence Address	JAY H GELLER JAY H GELLER A PROFESSIONAL CORPORATION 12100 WILSHIRE BL, SUITE 500 LOS ANGELES, CA 90025 UNITED STATES jhgeller@aol.com
Submission	Other Motions/Papers
Filer's Name	Jay H. Geller
Filer's e-mail	jhgeller@aol.com
Signature	/jhgeller/
Date	08/19/2014
Attachments	SummunResponseMtnDismiss.pdf(128568 bytes ) SummunOfficeAction.pdf(1225102 bytes )

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Guinot, a French societe par	)	
actions simplifiee,	)	Opp. No. 91215553
	)	
Opposer,	)	RESPONSE TO APPLICANT'S
	)	MOTION TO DISMISS
v.	)	
Ebel International Limited	)	
	)	
Applicant.	)	
<hr/>		)

Applicant has filed a Motion to Dismiss the Opposition on several grounds. One ground for the Motion to Dismiss - there is no likelihood of confusion between its mark and that of Opposer - appears to make this Opposition moot.

BACKGROUND

This Opposition was filed because the examiner on Opposer's application, 85885354 for the mark SUMMUM, cited the Applicant's mark, Serial No. 85840883 for SUMMUM L'BEL as a possible basis for refusing registration to Opposer. The office action was issued on July 3, 2013 (copy attached) and states in pertinent part :

Information regarding pending Application Serial No. 85840883 is enclosed. The filing date of the referenced application precedes applicant's filing date. There may be a likelihood of confusion between the two marks under Trademark Act Section 2(d), 15 U.S.C. §1052(d). If the referenced application registers, registration may be refused in this case under Section 2(d). 37 C.F.R. §2.83; TMEP §§1208 *et seq.* Therefore, upon entry of a response to this Office action, action on this case may be suspended pending final disposition of the earlier-filed application.

In light of this office action, Opposer filed this Opposition matter to resolve the issue of likelihood of confusion. (Further action on Opposer's application has been suspended.)

In its Motion to Dismiss, Applicant makes clear that there is no likelihood of confusion between its mark SUMMUM L'BEL and Opposer's mark SUMMUM. Applicant has already submitted a request to the examiner on its application to withdraw the citation and approve the application for publication for Opposition based on Applicant's admissions before the Board.

In pertinent part, Applicant states:

Moreover, the Complaint should have set forth the basic facts supporting a claim based on likelihood of confusion, which include, allegations as to the similarity of the marks in sight, sound, and/or meaning; similarity of the goods and/or services; similarity of trade channels and classes of purchasers of the goods and/or services; the fame of Opposer's Mark, the similarity of the conditions under which buyer's encounter Opposer's and Applicant's marks, and the nature and extent of any actual confusion. See *In Re E.I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 U.S.P.Q. 563 (C.C.P.A. 12973). In connection with the above, Plaintiff only made the following claim: "Applicant's mark and Opposer's trademark are identical in sound, spelling, and appearance." Complaint, ¶ 5. **In doing so, Plaintiff alleges that Applicant's Mark is only the word "SUMMUM", but very conveniently ignores the complete mark, which is "SUMMUM L'BEL". In other words, the marks at issue, although**

they may share one word, are not the same as erroneously alleged by Plaintiff. Evidently, the Applicant Mark and Opposer Mark are not identical in sound, spelling, and/or appearance. Additionally, Plaintiff acknowledges that the Applicant's Mark was filed "for fragrances and deodorants" and, in contrast, "Opposer's application does not request registration for any fragranced products or deodorants." Complaint, ¶¶ 3 and 4. That is, the Applicant and Opposer Marks are for different products under Class 03. See SUMMUM L'BEL Trademark/Service Mark Application. As the Applicant Mark and Opposer Mark serve as identifier for different types of goods, there could be no factual basis to claim likelihood of confusion of different products between both marks. In short, Plaintiff in this case has not alleged priority of use of its mark in the United States, not in Europe, in order to be able to allege that it has priority of use in the United States, as well as its likelihood of confusion claim. Moreover, the marks are different, as the Applicant's Mark contains the words "SUMMUM L'BEL", and is for different products to those of Plaintiff, there could be no likelihood of confusion, as per the Complaint's own allegations. Thus, Applicant respectfully submits that no claim upon which relief may be granted has been stated in connection with the alleged ground of "priority and likelihood of confusion" and that this ground should be dismissed. (Emphasis added)

Based on Applicant's own admissions that its mark and applicant's mark are not identical, that the SUMMUM portion of the two marks is not

significant, that applicant's mark as a whole - SUMMUM L'BEL - is not the same as applicant's mark, that the two marks are not identical in "sound, spelling and/or appearance" and that the goods of the two parties are so different that "there could be no factual basis to claim likelihood of confusion of different products between both marks", there is no likelihood of confusion in the marketplace. Even if Applicant's application proceeds to registration, there is no basis for the examiner on Opposer's application to refuse registration to Opposer based on likelihood of confusion with Applicant's mark or for Applicant to oppose Opposer's application. Indeed, Applicant admits that the marks can peacefully coexist on the Principal Register and in commerce in the United States because there is no likelihood of confusion as to source of the goods of the two entities.

Since Applicant admits that there is no likelihood of confusion between its mark SUMMUM L'BEL and Opposer's SUMMUM, there is no bar to Opposer's application moving forward to publication for Opposition in the Official Gazette. Opposer respectfully requests that the Board Order the examiner on Serial No. 85885354 to approve Opposer's application for publication in the Official Gazette and dismiss this Opposition.

Dated: August 19, 2014

/jhgeller/  
Jay H. Geller  
Jay H. Geller, A  
Professional Corporation  
Attorneys for Opposer

I certify that the foregoing is being deposited with the United

States Postal Service as first class mail, postage prepaid, in an envelope addressed to the Mauricio Muniz, O'Neill & Borges, LLC, 250 Munoz Rivera Ave., Suite 800, San Juan, PR 00918-1813 on August 19, 2014.

/jhgeller/  
Jay H. Geller

**To:** Guinot ([jhgeller@aol.com](mailto:jhgeller@aol.com))  
**Subject:** U.S. TRADEMARK APPLICATION NO. 85885354 - SUMMUM - N/A  
**Sent:** 7/3/2013 3:13:01 PM  
**Sent As:** ECOM117@USPTO.GOV  
**Attachments:** [Attachment - 1](#)  
[Attachment - 2](#)  
[Attachment - 3](#)  
[Attachment - 4](#)

**UNITED STATES PATENT AND TRADEMARK OFFICE (USPTO)  
OFFICE ACTION (OFFICIAL LETTER) ABOUT APPLICANT'S TRADEMARK APPLICATION**

**U.S. APPLICATION SERIAL NO.** 85885354

**MARK:** SUMMUM

**\*85885354\***

**CORRESPONDENT ADDRESS:**

JAY GELLER  
12100 WILSHIRE BLVD STE 500  
LOS ANGELES, CA 90025-7121

**CLICK HERE TO RESPOND TO**  
<http://www.uspto.gov/trademarks/teas/r>

**APPLICANT:** Guinot

**CORRESPONDENT'S REFERENCE/DOCKET NO :**

N/A

**CORRESPONDENT E-MAIL ADDRESS:**

[jhgeller@aol.com](mailto:jhgeller@aol.com)

**OFFICE ACTION**

**STRICT DEADLINE TO RESPOND TO THIS LETTER**

TO AVOID ABANDONMENT OF APPLICANT'S TRADEMARK APPLICATION, THE USPTO MUST RECEIVE APPLICANT'S COMPLETE RESPONSE TO THIS LETTER **WITHIN 6 MONTHS** OF THE ISSUE/MAILING DATE BELOW.

**ISSUE/MAILING DATE:** 7/3/2013

The referenced application has been reviewed by the assigned trademark examining attorney. Applicant must respond timely and completely to the issue(s) below. 15 U.S.C. §1062(b); 37 C.F.R. §§2.62, 2.65(a); TMEP §§711, 718.03.

**SEARCH**

The Office records have been searched and no similar *registered* mark has been found that would bar registration under Trademark Act Section 2(d), 15 U.S.C. §1052(d). TMEP §704.02. However, please be advised that a potentially conflicting mark in a prior-filed pending application may present a bar to registration.

Information regarding pending Application Serial No. 85840883 is enclosed. The filing date of the referenced application precedes applicant's filing date. There may be a likelihood of confusion between the two marks under Trademark Act Section 2(d), 15 U.S.C. §1052(d). If the referenced application registers, registration may be refused in this case under Section 2(d). 37 C.F.R. §2.83; TMEP §§1208 *et seq.* Therefore, upon entry of a response to this Office action, action on this case may be suspended pending final disposition of the earlier-filed application.

If applicant believes there is no potential conflict between this application and the earlier-filed application, then applicant may present arguments relevant to the issue in a response to this Office action. The election not to submit arguments at this time in no way limits applicant's right to address this issue at a later point.

### **TRANSLATION INQUIRY**

Applicant must specify whether "SUMMUM" in the mark has any meaning in a foreign language. *See* 37 C.F.R. §2.32(a)(9); TMEP §§809, 814. An applicant must submit an English translation of all foreign wording in a mark. 37 C.F.R. §2.32(a)(9); TMEP §809.

Accordingly, if the wording has meaning in a foreign language, applicant should provide the following translation statement:

**The English translation of the word "SUMMUM" in the mark is "highlight".**

TMEP §809.03.

Alternatively, if the wording does not have meaning in a foreign language, applicant should provide the following statement:

**The wording "SUMMUM" has no meaning in a foreign language.**

*Id.*

It is generally not necessary to translate words from dead or obscure languages. *Cf. General Cigar Co. Inc. v. G.D.M. Inc.*, 988 F. Supp. 647, 45 USPQ2d 1481 (S.D.N.Y. 1997) (applicant had no obligation to disclose that the term COHIBA for cigars means "tobacco" in the language of the Taino Indians in the Dominican Republic, because cigar smokers in the United States would not be aware of such a meaning). <http://rdms-tmep-vip.uspto.gov/RDMS/detail/manual/TMEP/Apr2013/TMEP-ch-800-3d85e5540> For example, Latin is generally considered a dead language. However, if there is evidence that a Latin term is still in use by the relevant purchasing public (e.g., if the term appears in news articles), then a Latin term is not considered dead.

Although "summum" appears to be of Latin origin, applicant must indicate whether "summum" is used in French or other living language.



## **COMMENTS**

If applicant has questions about its application or needs assistance in responding to this Office action, please telephone the assigned trademark examining attorney directly at the number below.

**TEAS PLUS APPLICANTS MUST SUBMIT DOCUMENTS ELECTRONICALLY OR SUBMIT FEE:** Applicants who filed their application online using the reduced-fee TEAS Plus application must continue to submit certain documents online using TEAS, including responses to Office actions. *See* 37 C.F.R. §2.23(a)(1). For a complete list of these documents, see TMEP §819.02(b). In addition, such applicants must accept correspondence from the Office via e-mail throughout the examination process and must maintain a valid e-mail address. 37 C.F.R. §2.23(a)(2); TMEP §§819, 819.02(a). TEAS Plus applicants who do not meet these requirements must submit an additional fee of \$50 per international class of goods and/or services. 37 C.F.R. §2.6(a)(1)(iv); TMEP §819.04. In appropriate situations and where all issues can be resolved by amendment, responding by telephone to authorize an examiner's amendment will not incur this additional fee.

/Hanno Rittner/  
Trademark Examining Attorney  
Law Office 117  
(571) 272-7188  
hanno.rittner@uspto.gov

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**All informal e-mail communications relevant to this application will be placed in the official application record.**

**WHO MUST SIGN THE RESPONSE:** It must be personally signed by an individual applicant or someone with legal authority to bind an applicant (i.e., a corporate officer, a general partner, all joint applicants). If an applicant is represented by an attorney, the attorney must sign the response.

**PERIODICALLY CHECK THE STATUS OF THE APPLICATION:** To ensure that applicant does not miss crucial deadlines or official notices, check the status of the application every three to four months using the Trademark Status and Document Retrieval (TSDR) system at <http://tsdr.uspto.gov/>. Please keep a copy of the TSDR status screen. If the status shows no change for more than six months, contact the Trademark Assistance Center by e-mail at [TrademarkAssistanceCenter@uspto.gov](mailto:TrademarkAssistanceCenter@uspto.gov) or call 1-800-786-9199. For more information on checking status, see <http://www.uspto.gov/trademarks/process/status/>.

**TO UPDATE CORRESPONDENCE/E-MAIL ADDRESS:** Use the TEAS form at <http://www.uspto.gov/trademarks/teas/correspondence.jsp>.



**Print: Jul 3, 2013**

**85840883**

**DESIGN MARK**

**Serial Number**

85840883

**Status**

NON-FINAL ACTION - MAILED

**Word Mark**

SUMMUM L'BEL

**Standard Character Mark**

Yes

**Type of Mark**

TRADEMARK

**Register**

PRINCIPAL

**Mark Drawing Code**

(4) STANDARD CHARACTER MARK

**Owner**

Ebel International Limited CORPORATION BERMUDA Cedar House 41 Cedar Avenue Hamilton BERMUDA HM12

**Goods/Services**

Class Status -- ACTIVE. IC 003. US 001 004 006 050 051 052. G & S: Fragrances, perfumes, cologne, deodorants for personal use, aftershave lotion.

**Filing Date**

2013/02/05

**Examining Attorney**

FRAZIER, TAMARA

**Attorney of Record**

Cristina A. Carvalho

SUMMUM L'BEL



This is vintage comedy at its best.	<b>exp.</b> C'est le <b>summun</b> des grands classiques de la c ...
This car is the ultimate in luxury.	<b>exp.</b> Cette voiture est le <b>summun</b> du luxe.
a writer at the height of his powers	<b>exp.</b> un écrivain au <b>summun</b> de sa puissance

"Collins English French Electronic Dictionary © HarperCollins Publishers 2005"



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**To:** Guinot ([jhgeller@aol.com](mailto:jhgeller@aol.com))  
**Subject:** U.S. TRADEMARK APPLICATION NO. 85885354 - SUMMUM - N/A  
**Sent:** 7/3/2013 3:13:02 PM  
**Sent As:** ECOM117@USPTO.GOV  
**Attachments:**

**UNITED STATES PATENT AND TRADEMARK OFFICE (USPTO)**

**IMPORTANT NOTICE REGARDING YOUR  
U.S. TRADEMARK APPLICATION**

USPTO OFFICE ACTION (OFFICIAL LETTER) HAS ISSUED  
ON **7/3/2013** FOR U.S. APPLICATION SERIAL NO. 85885354

Please follow the instructions below:

**(1) TO READ THE LETTER:** Click on this [link](#) or go to <http://tsdr.uspto.gov>, enter the U.S. application serial number, and click on “Documents.”

The Office action may not be immediately viewable, to allow for necessary system updates of the application, but will be available within 24 hours of this e-mail notification.

**(2) TIMELY RESPONSE IS REQUIRED:** Please carefully review the Office action to determine (1) how to respond, and (2) the applicable response time period. Your response deadline will be calculated from **7/3/2013** (*or sooner if specified in the Office action*). For information regarding response time periods, see <http://www.uspto.gov/trademarks/process/status/responsetime.jsp>.

**Do NOT hit “Reply” to this e-mail notification, or otherwise e-mail your response** because the USPTO does NOT accept e-mails as responses to Office actions. Instead, the USPTO recommends that you respond online using the Trademark Electronic Application System (TEAS) response form located at [http://www.uspto.gov/trademarks/teas/response\\_forms.jsp](http://www.uspto.gov/trademarks/teas/response_forms.jsp).

**(3) QUESTIONS:** For questions about the contents of the Office action itself, please contact the assigned trademark examining attorney. For *technical* assistance in accessing or viewing the Office action in the Trademark Status and Document Retrieval (TSDR) system, please e-mail [TSDR@uspto.gov](mailto:TSDR@uspto.gov).

**WARNING**

**Failure to file the required response by the applicable response deadline will result in the ABANDONMENT of your application.** For more information regarding abandonment, see

<http://www.uspto.gov/trademarks/basics/abandon.jsp>.

**PRIVATE COMPANY SOLICITATIONS REGARDING YOUR APPLICATION:** Private companies **not** associated with the USPTO are using information provided in trademark applications to mail or e-mail trademark-related solicitations. These companies often use names that closely resemble the USPTO and their solicitations may look like an official government document. Many solicitations require that you pay “fees.”

Please carefully review all correspondence you receive regarding this application to make sure that you are responding to an official document from the USPTO rather than a private company solicitation. All official USPTO correspondence will be mailed only from the “United States Patent and Trademark Office” in Alexandria, VA; or sent by e-mail from the domain “@uspto.gov.” For more information on how to handle private company solicitations, see [http://www.uspto.gov/trademarks/solicitation\\_warnings.jsp](http://www.uspto.gov/trademarks/solicitation_warnings.jsp).